

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket № 14967US02

In the Application of:

Jeyhan Karaoguz, et al.

Serial No.: 10/667,036

Filed: September 22, 2003

For: BILLING SUPPORT IN A
MEDIA EXCHANGE NETWORK

Examiner: HAMILTON, LALITA

Group Art Unit: 3691

Conf. No.: 7866

Electronically Filed on November 6, 2009

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Paper responds to the Examiner's Answer mailed September 16, 2009. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-53 of the present application for at least the reasons set forth in the Appeal Brief and this Reply Brief.

REMARKS

The Applicants note that the Examiner's Answer essentially tracks the October 7, 2008 Office Action. *Compare* Examiner's Answer at pages 3-9 *with* October 7, 2008 Office Action at pages 2-8. Accordingly, the Appeal Brief addresses these arguments at pages 12-23.

I. Update Of Related Appeals And Interferences

As an initial matter, the Applicants respectfully update the "Related Appeals and Interferences" Section of the Appeal Brief as follows:

The following appeals may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal:

- U.S. App. No. 10/675,467, filed September 30, 2003
- U.S. App. No. 10/675,057, filed September 30, 2003
- U.S. App. No. 10/667,833, filed September 22, 2003
- U.S. App. No. 10/672,251, filed September 26, 2003
- U.S. App. No. 10/672,864, filed September 26, 2003
- U.S. App. No. 10/675,358, filed September 30, 2003

The Applicants are not presently aware of any decisions that have been rendered with respect to any of the Appeals noted above.

II. The Examiner's Answer Fails To Provide An Explicit Analysis To Support The Claim Rejections

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation** of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the **analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.** The Federal Circuit has stated that "rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ.2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ.2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added).

Notably, in the isolated instances when the Examiner's Answer cites support from *Schein*, the Examiner's Answer cites the **exact same portions of Schein almost every single time**. In particular, the Examiner's Answer cites *Schein* at Figures "fig. 14A-E; co1. (sic) 14, line 18 to co1. (sic) 15, line 30; and co1. (sic) 19, lines 5-30" as the only support from *Schein* **for each limitation of the claims to which the Office Action alleges Schein is relevant**. See Examiner's Answer at pages 3-9. The Applicants respectfully submit, however, that such a general, summary, blanket citation cannot be applicable to **each** of the limitations. Instead, such an approach provides further evidence that neither the Office Action, nor the Examiner's Answer, establishes a *prima facie* case of unpatentability with respect to the pending claims. That is, the Office Action and the Examiner's Answer fail to provide an explicit analysis supporting the rejection. See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ.2d 1329, 1336

(Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ.2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added)

III. Schein Does Not Describe, Teach Or Suggest A Media Channel Defined Or Created By A User

The Applicants demonstrate that Schein does not describe, teach or suggest “a user interface for the selection and display of media content, at the first home, the user interface allowing at least one user to create at least one user defined media channel, wherein the at least one user selects media content for the at least one user defined media channel through the user interface, and the at least one user specifies, through the user interface, times when the user selected media content will be made available on the at least one user defined media channel, the user interface displaying a graphical representation of the at least one user defined media channel, the at least one user defined media channel comprising a sequence of the user selected media content for consumption at the times specified by the at least one user,” as recited in claim 1, for example. See Appeal Brief at pages 13-16.

Indeed, the Applicants stress that the claim is clear that a user defined media channel, not merely a schedule or listing of information from other channels, is recited in the claims.

The Examiner’s Answer maintains the position set forth in the Office Action and now cites to Schein at column 14, line 55 to column 15, line 15. See Examiner’s Answer at page 10. However, this cited portion of Schein merely notes a “television schedule guide.” See Schein at column 14, line 56. “The television schedule guide or website may

be configured for viewing and interacting with television information directly on-line, or it may be configured for downloading the information into a computer hard drive or other suitable processor.” See *id.* at column 14, lines 61-64. While the guide “will provide listings information for all channels **in the viewer’s local cable lineup**” (see *id.* at column 14, lines 64-66 (emphasis added)), there is nothing in this cited portion, nor the remainder, of Schein that describes, teaches or suggests a “user defined media channel,” as explained in the Appeal Brief. The cited portion notes “creating personalized TV listings” (see *id.* at column 14, lines 66-67), but a mere listing is not a “user-defined media channel.” Merely listing a channel from a “viewer’s local cable lineup” is by no means a user defining/creating his/her own channel (i.e., a “user-defined media channel”). Instead, the guide of Schein merely allows a viewer “to call up favorite programming choices” (see *id.* at column 14, line 67 to column 15, line 3) from existing channels, such as a “local cable lineup,” but not that the user defines or creates his/her own channels, as recited in claims 1 and 29, for example.

As noted in the Appeal Brief, “Schein discloses a system and method that merely allows a viewer to customize a program guide so that the particular viewer will not miss programs from various channels that he/she wants to view. Schein does not describe, teach or suggest, however, “a user interface for the selection and display of media content, at the first home, the user interface allowing at least one user to create at least one **user defined media channel**, wherein the at least one user selects media content for the at least one **user defined media channel** through the user interface, and the at

least one user specifies, through the user interface, times when the user selected media content will be made available on the at least one **user defined media channel**, the user interface displaying a graphical representation of the at least one **user defined media channel**, the at least one **user defined media channel** comprising a sequence of the user selected media content for consumption at the times specified by the at least one user,” as recited in claim 1, for example, or “at least one processor operably coupled to the at least one interface and to storage containing executable code enabling **creation by a first user at the first location of one or more media channels** for distribution to an authorized second user at a second location remote from the first location,” as recited in claim 29, for example. For at least these reasons, and those set forth in the Appeal Brief, the Applicants respectfully request reconsideration of the claim rejections.

IV. The Future Of TV Does Not Cure The Deficiencies Of Schein – It’s Not Even Enabling Prior Art

The Applicants also demonstrate that The Future of TV does not cure the deficiencies of Schein. See Appeal Brief at pages 20-23. Indeed, The Future of TV is not even enabling prior art. See *id.* at pages 22-23.

The Examiner’s Answer asserts, however, the following:

The Appellant further argues that Future TV is forward looking and does not describe the technology as it existed at the time the article was written. In response, the Appellant’s assertion is a conclusion, and there is **no support on record** to the contrary.

See Examiner’s Answer at page 12 (emphasis added).

The Applicants respectfully submit, however, that neither the Office Action, nor the Examiner's Answer, establishes that The **FUTURE of TV** is enabling prior art. Indeed, there is plenty of "support on record" – explicit statements in The Future of TV itself. It is not the Applicants' duty to establish a *prima facie* case of unpatentability. Instead, that duty is reserved for the Examiner.

The Applicants cite various portions of The Future of TV that clearly and unambiguously indicate that, according to that reference, the public simply was not in possession of the technology set forth in The **FUTURE of TV** at the time that article was published. See Appeal Brief at pages 22-23. Indeed, The Future of TV indicates that "custom TV" was not reality at the time the article was published. See *id.* Accordingly, the Applicants provide ample evidence **from the reference itself** that establishes that The Future of TV is not enabling prior art. The Examiner's Answer provides absolutely no evidence that the public was in possession of the "future" technology discussed in The Future of TV at the time that reference was published. Notably, the Examiner's Answer does not even attempt to address the specific examples set forth in the Appeal Brief establishing that this reference is non-enabling prior art. Instead, the Examiner's Answer only offers the summary conclusion noted above. See Examiner's Answer at page 12. Thus, for at least these reasons and those set forth in the Appeal Brief, the Applicants respectfully request reconsideration of the claim rejections.

V. CONCLUSION

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-53.

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: November 6, 2009

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